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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,901	09/15/2003	Scott G. Meikle	108298511US1	1279
25096	7590	12/28/2005	EXAMINER	
PERKINS COIE LLP			VINH, LAN	
PATENT-SEA			ART UNIT	
P.O. BOX 1247			PAPER NUMBER	
SEATTLE, WA 98111-1247			1765	
DATE MAILED: 12/28/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/662,901

Applicant(s)

MEIKLE, SCOTT G.

Examiner

Lan Vinh

Art Unit

1765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24-34 is/are pending in the application.
- 4a) Of the above claim(s) 30-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/9/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I, claims 24-29 in the reply filed on 11/3/2005 is acknowledged.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25, 29 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 25, 29 recite the limitation "the surface of the liquid" in claim 24. There is insufficient antecedent basis for this limitation in the claim.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 24, 27 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. US 6,736,869 in view of Holmes et al (US 5,690,705)

Claim 1 of US 6,736,869 meets all the limitations of claims 24, 27 of the instant claimed invention except the step of engaging the support material with a backing material and moving the backing material away from the liquid.

Holmes discloses a method of making a coated abrasives articles comprises the steps of coating or placing the shaped abrasive particles onto the backing material (col 15, lines 27-30), removing the binder material from the carrier web/backing material (col 5, lines 14-16; fig. 2), which reads on moving the backing material away from the support liquid. Thus, one skilled in the art at the time the invention was made would have found it obvious to modify claim 1 of US 6,736,869 by adding the steps of placing the shaped abrasive particles/discrete element onto the backing material and removing the binder material from the carrier web/backing material in view of Holmes teaching because Holmes discloses that the abrasive particles can be coated or placed randomly onto the backing (col 15, lines 26-28)

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24-25, 27-29 rejected under 35 U.S.C. 102(b) as being anticipated by  
Holmes et al (US 5,690,705)

Holmes discloses a method of making a coated abrasives articles. This method comprises the steps of:

subjecting the binder layer/claimed support material to a source of water (col 5, lines 16-23), which reads on floating a film of a support material on a support liquid

converting the binder precursor of thermosetting resin/claimed planarizing material into abrasive particles (col 1, lines 64-65; col 13, lines 15-17), which reads on separating a planarizing medium material into discrete elements

disposing the abrasive grits 112 /discrete elements on a binder film 114, the binder can include water or organic solvent (col 11, lines 16-17, col 13, lines 66-67; fig. 5 ), which reads on disposing the discrete element and a film support material on a support liquid. Fig. 5 of Holmes shows that the abrasive grits/ 112 spaced apart from each other and protruding/projecting from the binder film /support material

coating or placing the shaped abrasive particles onto the backing material (col 15, lines 27-30), removing the binder material ( the binder can include water or organic solvent as recited in col 11, lines 16-17) from the carrier web/backing material (col 5,

lines 14-16; fig. 2), which reads on moving the backing material away from the support liquid

The limitations of claim 27 has been discussed above

Regarding claim 25, Holmes discloses converting the binder precursor of thermosetting resin/claimed planarizing material into abrasive particles /separating a planarizing medium material into discrete elements and mixing the discrete element with the support material before subjecting the binder layer/claimed support material to a source of water (col 5, lines 5-21)

Regarding claim 28, Holmes disposing the abrasive grits 112 /discrete elements on a binder film 114/support material after subjecting the binder layer/claimed support material to a source of water/liquid (col 65-67)

Regarding claim 29, Holmes discloses that the binder/support material is broken or crushed to form the particles (col 13, lines 28-32) and subjecting the binder to a source of water (col 5, lines 20-22), which reads on disposing the support material on the surface of the liquid to a thickness of one molecule

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes et al (US 5,690,705) in view of Godschalx et al (US 5,965,679)

Holmes method has been described above. Unlike the instant claimed invention as per claim 26, Holmes fails to disclose selecting an organic Langmiur-Blodgett film material as the supporting material

Godschalx discloses a method for using polymer in microelectronic fabrication comprises the step of depositing a multilayer film by a Langmiur-Blodgett techniques (col 17, lines 61-63)

One skilled in the art at the time the invention was made would have found it obvious to modify Holmes by using Langmiur-Blodgett film material as the supporting material in view of Godschalx teaching because Godschalx discloses that mono and multilayer films can also be deposited onto a substrate using a Langmiur-Blodgett technique (col 17, lines 60-65)

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lan Vinh whose telephone number is 571 272 1471. The examiner can normally be reached on M-F 8:30-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine Norton can be reached on 571 272 1465. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'LV', written in a cursive style.

LV  
December 22, 2005